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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,667	10/17/2000	Steven MacWilliams	224.013US1	3418

7590

08/27/2002

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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/690,667

Applicant(s)

MACWILLIAMS, STEVEN

Examiner

Monica S. Carter

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3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on July 31, 2002, for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/690,667 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham ('144) in view of Verhines ('130).

Cunningham discloses a label for attaching over an edge of a stock (as seen in figures 1, 5, 6, and 8), the label comprises a first layer (21, 22) having a first surface adapted to be printed on (as seen in figure 2) and a second surface (undersurface of 21, 22); a second layer (11) including a non-adhesive label material which is permanently attached to the second surface of the first layer (see col. 2, lines 26-31); the second layer having an adhesive on an outer surface of the non-adhesive label material (see col. 2, lines 23-26); the second layer covers substantially all of the second surface of the first layer (as seen in figure 2); the label folds along a fold line section such that a first section of the second layer is attachable to a first side of the stock

member and a second section of the second layer is attachable to a second side of the stock member (as seen in figures 5 and 8).

Cunningham discloses the claimed invention except for a gap (discontinuity) in the second layer comprising a series of perforations separating the first and second sections.

Verhines discloses tab material that is wrapped tightly around an edge of a sheet and adhered to both faces of the sheet comprising a first layer (74) having a first surface adapted to be printed on (as seen in figure 2) and a second surface; a second layer (82, 90) permanently attached to the second surface of the first layer; the second layer comprising a first (82) and second (90) section having a gap (area located proximate element 78 in figure 3) therebetween; the gap defining a fold-line section in the first layer. In figure 3, Verhines discloses the second layer (82, 90) being discontinuous at edge (78). Inherently, this discontinuity would provide a perforation line where the edge and the ends of the second layer meet providing a plurality of perforations.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Cunningham's to include a gap in the second layer separating the first and second sections, as taught by Verhines, to reduce the thickness of the label assembly at the area that is to be folded over the stock material providing a secure attachment between the label and the stock material.

Regarding claims 6 and 20, Cunningham, as modified by Verhines, discloses that the fold-line section (area proximate element 78) is offset from a centerline of the first layer (see figure 3 of Verhines).

Regarding claim 7, Cunningham, as taught by Verhines, teaches only one gap in the second layer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any number of gaps in the second layer as desired by the end user, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 8, Cunningham, as taught by Verhines, discloses that neither the first section nor the second section of the second layer bend when the folding pressure is applied to the label (as seen in figures 1 and 5).

Regarding claims 9-14, 21, 23 and 29, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material having different characteristics such as color depending on the desired end result, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

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Regarding claims 15-17, Cunningham, as modified by Verhines, discloses the gap indicates a label fold-line in the first layer for matching with the edge of the stock member and the first layer folds along the fold-line section when a force is applied (as seen in figure 3 of Verhines).

Regarding claim 22, see the above rejections to claims 1, 9, 10, 15 and 16.

Regarding claim 24, see the above rejections.

Regarding claim 25, see the above rejections.

Regarding claim 26, Cunningham, as modified by Verhines, discloses the claimed invention except for the label having a backing member. It is commonly known to provide removable backing liners (such as silicone-based liners) to adhesive labels. It would have been obvious to one having ordinary skill in the art to provide a backing member to the label of Cunningham to provide a protective covering for the adhesive layer and then remove the covering when the label is to be applied to a stock material.

Regarding claim 27, Cunningham, as modified by Verhines, discloses one or more label members (13, 14) attached to the at least two section of the second layer (as seen in figures 2, 5 and 8).

Regarding claim 28, Cunningham, as modified by Verhines, discloses each of the label members (13, 14) having a perimeter edge which matches an edge of the at sections of the second layer (as seen in figure 2).

Regarding claims 30-33, the method of applying the label to an edge of a stock member is disclosed above.

Regarding claim 34, see the above rejections to claims 1, 10, 15 and 16.

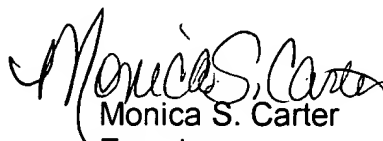
### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
Monica S. Carter  
Examiner  
Art Unit 3722  
August 23, 2002